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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,997	01/16/2004	Mark T. Marshall	P0020093.00/LG10126	8682
27581	7590	12/23/2010		
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER ALTER, ALYSSA MARGO	
			ART UNIT 3762	PAPER NUMBER
			NOTIFICATION DATE 12/23/2010	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.docketingus@medtronic.com  
sso@cardinal-ip.com

# Office Action Summary

**Application No.**

10/759,997

**Applicant(s)**

MARSHALL ET AL.

**Examiner**

Alyssa M. Alter

**Art Unit**

3762

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6 and 8-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-6 and 8-34 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3-6 and 8-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Halperin et al. (US 5,564,434 A) in view of Anderson et al. (US 4,552,432). Halperin et al. discloses a lead body with a sensor module as seen in figures 2 and 3. "The pressure sensor module 20 is located just proximal to the distal tip tine assembly 26 and is mechanically and electrically connected to the coaxial, outer and inner, coiled wire lead conductors 14 and 16"(col. 7, lines 20-24). The two wire lead conductors, 14 and 16, are separated by an inner insulating sleeve 46 and encased by an outer insulating sleeve 46. Since coil 16 is disposed within coil 14, the examiner considers conductor 14 to be the coil conductor and coil 16 to be the cable conductor disposed within conductor 14. As seen in figure 3,

the cable conductor is comprised two coiled wires. Halperin discloses inner and outer coils, 14 and 16 depicted in figure 3.

Halperin discloses the device substantially as claimed except for the conduct having an inner and outer coil created from a plurality of wire strands. Anderson et al. discloses a multilayered inner and outer coil comprised of multiple wire strands (see figure 1; col. 2, lines 8-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable coiling as disclosed by Halperin et al. with the multilayered inner and outer multiple wire strand coils as disclosed by Anderson et al. in order to provide the predictable results of improving tensile strength, protecting the inner coil and reducing the interference of the carried signals.

Additionally, the electrically insulative layer between the two conductors is the insulating sleeve 22 (Halperin, figure 3). Furthermore, since the insulative sleeve covers the cable conductor (coil 16), the examiner considers it to be a coating over cable conductor.

Alternatively, although the examiner considers the modified Halperin et al. to disclose an insulative coating above, it would have been obvious at the time the invention was made to substitute the insulative sleeve over the cable conductor with an insulative coating on the exterior in order to yield the predictable results of insulating the conductor and reducing the diameter of the lead.

Furthermore, Halperin et al. discloses the use of polyurethane insulation, which has a dielectric coefficient or dielectric constant less than 10. Since the coil 14 and the

coil 16 are formed from two separate components, there is necessarily a gap between the two, since they are not unitary.

Halperin et al. discloses the claimed invention except for the specific ranges of the size of the coil, insulation and the gap dimensions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the size of the coil, insulation and the gap dimensions, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (see MPEP 2144.05). Furthermore, determining the most appropriate size by routine experimentation would be prima facie obvious to one having ordinary skill in the art.

Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the size and dimension of the lead components as taught by Halperin et al. with a specific range since it was known in the art that modifications to the size and dimension of lead components to create a larger or more compact lead, the would modify the lead to meet specific patient needs.

As to claims 3, 8-14, 22-29, Halperin et al. discloses the claimed invention except for the preferred material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the the employed material as taught by Halperin et al. with the preferred material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416 (See MPEP 2144.07).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Alter whose telephone number is (571)272-4939. The examiner can normally be reached on M-F 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Niketa Patel can be reached on (571) 272-4156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Niketa I. Patel/  
Supervisory Patent Examiner, Art Unit 3762

/Alyssa M Alter/  
Examiner  
Art Unit 3762